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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/788,097	02/20/2001	Jiong John Jiang		4009

7590 10/03/2002
Jiong John Jiang
1320 Stonegate Road
Algonquin, IL 60102

EXAMINER

ALPHONSE, FRITZ

ART UNIT	PAPER NUMBER
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2675

DATE MAILED: 10/03/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/788,097

Applicant(s)
Jiong J. Jiang *JJ*

Examiner
Fritz Alphonse

Art Unit
2675



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 20, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Arrangement of the Specification

The following order or arrangement is preferred in framing the specification and, except for the reference to the drawings, each of the lettered items should appear in upper case, without underling or bold type, as section headings. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

1. The following guidelines illustrate the preferred layout and content for patent applications. These guidelines are suggested for the applicant's use.

- (a) Title of the Invention.
- (b) Cross-Reference to Related Applications.
- © Statement Regarding Federally Sponsored Research or Development.
- (d) Reference to a "Sequence Listing," a table, or a computer program listing appendix submitted on compact disc (see 37 CFR 1.52(e)(5)).
- (e) Background of the Invention.
 - 1. Field of the Invention.
 - 2. Description of the Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) Brief Summary of the Invention.
- (g) Brief Description of the Several Views of the Drawing(s).
- (h) Detailed Description of the Invention.

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- (I) Claim or Claims (commencing on a separate sheet).
- (j) Abstract of the Disclosure (commencing on a separate sheet).
- (k) Drawings.
- (l) Sequence Listing, if on paper (see 37 CFR 1.821-1.825).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-13 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant does not describe how to build such a computer mouse for manipulated by the right hand of a user to control the operation of a computer.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-13 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative

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device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

6. Claims 10-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claims 10-13 recites the limitation "the method; the hookup software; the said touchpad; the additional part; the base holder;...the sequence;...etc" in claims 10-13. There is insufficient antecedent basis for these limitations in the claims.

8. Claims 10-13 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. All the steps required for operating the method as claimed in claims 10-13 are omitted. The applicant, in response to this action, is suggested to amend the claims to incorporate the steps necessary for performing the method.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. As best understood by the examiner, claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scholder (U.S. Pat. No. 5,805,144) in view of Barrett (U.S. Pat. No. 5,260,697).

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As to claim 1, Scholder (figs. 1-2) show a computer mouse for manipulating by the right hand of a user to control the operation of a computer, comprising a handheld unit (211), a base holder (210) and its hookup software. The handheld unit (213) is operated solely by a user's right thumb when handheld. When the handheld unit (211) is placed on the base holder (210), it can function as a regular touchpad mouse (220).

Scholder does not explicitly teach about a mouse that simulates keyboard inputs when the user touches on the touchpad surface on the top of the said handheld unit, by right thumb when handheld.

However, in the same field of endeavor, Barrett (fig. 11) teaches about a computer system wherein a mouse can be used to simulate keyboard inputs when the user touches on a tablet surface (see abstract).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to improve upon the user interface system, as disclosed by Barrett. Doing so would provide a user with better feedback concerning operation of the pointing-device.

As to claims 2-3, Scholder (fig. 2) shows a handheld unit comprises a touchpad (220), a housing holder (210) and mouse buttons (223, 224); the handheld unit is small enough to be held in a user's right hand in grasping grip.

As to claims 4-5, Scholder (fig. 2) shows a handheld unit which is of elliptic shape and credit card shape.

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As to claims 6-8, Scholder (figs. 1-2) show a handheld unit (200) which can be operated solely by a user's right thumb; the unit can have small flat or intruded buttons (223, 224), located in front of the said touchpad (220); the handheld unit is connected to its computer (100) through a regular cable (143). See figure 1.

11. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scholder and Barrett as applied to claim 1 above, and further in view of Swamy (U.S. Pat. No. 6,035,350).

As to claim 9, Scholder does not teach about a handheld unit connected remotely to a computer, through RF signals and IR signals. However, these limitations are clearly disclosed by Swamy (see abstract).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to improve upon the detachable I/O device, as disclosed by Swamy. By doing so a person presenting an audio-visual production is highly benefited by a capability to control a computer from a remote position.

As best understood by the examiner, method claims 10-13 correspond to apparatus claims 1-8. Therefore, they are analyzed as previously discussed in claims 1-8 above.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Anderson (U.S. Pat. No. 5,355,148) discloses a fingerprint mouse.

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Lee (U.S. Pat. No. 6,219,037) discloses a pointing device provided with two types of input means for a computer system.

Liao et al. (U.S. Pat. No. 6,392,637) discloses a computer system having a configurable touchpad-mouse button combination.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fritz Alphonse whose telephone number is (703) 308-8534.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Saras, can be reached at (703) 305-9720.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks Washington, D.C. 20231

or faxed to: (703) 872-9314 (for Technology Center 2600 only)

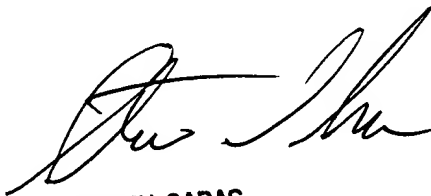
Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.


F. Alphonse

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September 24, 2002


STEVEN SARAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600